

REMARKS

By this amendment, claims 21-31 are amended. No new matter is introduced. Allowance of the claims in view of the above amendments and the remarks that follow is respectfully requested.

Applicant thanks Examiners Smithers and Teslovich for granting a personal interview with Applicant's representative on July 26, 2005. Claims 10-31 are pending. The substance of the interview is incorporated in the remarks that follow.

Rejections under 35 U.S.C. §112

Claims 21-31 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for reasons stated on page 2 of the Office Action. Specifically, the Examiner alleges that each claim recites both an apparatus and the method steps of using the apparatus. Applicant has amended claims 21-31 to recite only a portable viewer and its components. Applicant respectfully submits that the grounds of the rejections have been obviated and withdrawal of the rejections under 35 U.S.C. §112, second paragraph, is respectfully requested.

Rejections under 35 U.S.C. §101

Claims 21-31 stand rejected under 35 U.S.C. §101 for reasons stated on page 3 of the Office Action. Applicant has amended claims 21-31 to recite only a portable viewer and its components. Applicant respectfully submits that the grounds of the rejections have been obviated. Withdrawal of the rejections under 35 U.S.C. §101 is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 13-15, 20, 24-26 and 31 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,855,725 to Fernandez (hereinafter "Fernandez") in view of U. S. Patent No. 4,829,569 to Seth-Smith et al. (hereinafter "Seth-Smith") for reasons stated on pages 3-8 of the Office Action. Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) and *MPEP* §2142. In order to combine references, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention, and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

Independent claims 13 and 20 are directed to methods for restricting access to electronic books to an unique viewer. Independent claims 24 and 31 are directed to portable viewers that comprise a processor capable of restricting access to electronic books stored in the viewer to an unique viewer.

Fernandez generally describes a user interactive mass storage data access system including a personal computer and a simulated book (the CD book). The CD book is capable of communication with the personal computer through IR transmissions and allow a reader to read electronic books stored in a mass storage device, such as a CD-ROM, which is peripherally connected to the personal computer. The CD book has about 20 pages of memory so that it can be carried away from the computer and the pages can be displayed for later reading (col. 3, lines 18-22). Fernandez does not teach or suggest restricting access to electronic books stored in the viewer to an unique viewer. Nor does Fernandez provide any motivation, and hence desirability, to restrict access to the book pages stored in the CD book. The objective of Fernandez's invention is to provide the user of mass storage technology with the simplicity of the look and feel of a book while allowing access to a very large database (col. 2, lines 28-31). One of ordinary skill in the pertinent art would recognize that the CD book is just a user friendly accessory of a personal computer. Instead of sitting in front of the monitor of a personal computer, the CD book looks and feels like a real book, and allows a user to read an electronic book stored on a CD-ROM in a more comfortable setting. The CD book is designed to communicate with the computer through wireless transmissions so that the CD book itself has only a very limited memory (up to 20 pages). Under

the circumstances, there is no reason to restrict access to the pages stored in the CD book, since the whole book is stored on the CD-ROM and can be viewed on the personal computer. A person of ordinary skill in the art would recognize that even if one wants to restrict access to the electronic book, the logical approach would be to restrict access to the personal computer, where the electronic book is stored and displayed in its entirety, not the pages stored in the CD book. In addition, even assuming, *arguendo*, that one skilled in the art wants to restrict access to the text stored in the CD book, the method of restriction would most likely be a simple password restriction, not the complicated encrypting and decrypting technologies called for in claims 24 and 31.

During the interview, the examiner alleged that Fernandez teaches restricting access to the CD book, and cited col. 4, lines 15-20 of Fernandez as support. Applicant respectfully disagrees. Fernandez describes, in the cited sections, encoding and decoding data for IR transmission. One skilled in the art would understand that the encoding/decoding process referred to in Fernandez is a standard process necessary for transmitting data as IR signals. The process is not designed for data protection, nor was it used by Fernandez for the purpose of restricting access to the CD book. Fernandez also admits that the encoding/decoding process is well understood in the art and forms no part of the invention (col. 4, lines 20-25).

Seth-Smith generally describes a subscription TV system that provides individual subscribers with limited access to the TV program using encrypting and decrypting technologies. Seth-Smith, however, does not teach or suggest anything about electronic books, let alone the concept of distributing electronic books through a television network.

In view of the above, Applicant respectfully submits that the cited references fail to suggest the desirability and thus the obviousness of making the combination recited in claims 13, 20, 24 and 31. Moreover, one of ordinary skill in the art would not combine Fernandez with Seth-Smith without the benefit of impermissible hindsight afforded by the claimed invention. Accordingly, claims 13, 20, 24 and 31 are allowable. Applicant further submits that claims 14-15 and 25-26 are patentable because they depend from claim 13 or 24, and define additional patentable subject matter. Withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Claims 10-12, 16-19, 21-23 and 27-30 stand rejected under 35 U.S.C. §103(a) as being obvious over Fernandez in view of Seth-Smith and U.S. Patent No. 5,144,663 to Kudelski et al. (hereinafter "Kudelski") for reasons stated on pages 8-15 of the Office Action. Applicant respectfully traverses the rejection.

Independent claims 10 and 16 are directed to methods for restricting access to electronic books to an unique viewer. Independent claims 21 and 27 are directed to portable viewers that comprise a processor capable of restricting access to electronic books stored in the viewer to an unique viewer.

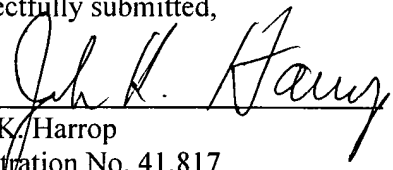
As discussed earlier, Fernandez deals with a CD book that is capable of wireless communication with a personal computer and display pages of an electronic book stored in the personal computer. Seth-Smith describes the traditional pay-per-view cable TV subscription system. When viewed without the benefit of impermissible hindsight afforded by the claimed invention, neither Fernandez nor Seth-Smith suggests the desirability and thus the obviousness of restricting access to electronic books stored in a portable viewer. Kudelski does not cure the deficiency of Fernandez and Seth-Smith. Kudelski generally describes a decoder used for a pay-TV system. Like Seth-Smith, Kudelski does not teach or suggest anything about electronic books and the concept of distributing electronic books through TV network. Therefore, Kudelski also fails to suggest the desirability and thus the obviousness of restricting access to electronic books stored in a portable viewer.

Accordingly, Applicant respectfully submits that claims 10, 16, 21 and 27 are allowable. Applicant further submits that claims 11-12, 17-19, 22-23 and 28-30 are patentable because they depend from claim 10, 16, 21 or 27, and define additional patentable subject matter. Withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested. Should the Examiner believe that anything is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Date: August 18, 2005

Respectfully submitted,



John K. Harrop
Registration No. 41,817
Andrews Kurth LLP
1701 Pennsylvania Ave, N.W.
Suite 300
Washington, DC 20006
Tel. (202) 662-3050
Fax (202) 662-2739